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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/940,954 | 08/28/2001 | Ulrich Meisen | Mo-6419/LeA 34,865 | 5188 |

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BAYER CORPORATION
PATENT DEPARTMENT
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EXAMINER

RODEE, CHRISTOPHER D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1756

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DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,954

Applicant(s)

MEISEN, ULRICH

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

⌞ The amendment filed 16 December 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the content of Mn as being determined by ICP-OES (spec. p. 9). The specification as filed states that the content of Mn is determined by atomic absorption spectroscopy. There is no basis in the specification as filed to indicate that the original disclosure was in error or that the "correction" now presented is the obvious correction when considered by the skilled artisan. Applicants have not provided an explanation for this change in the response.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims have been amended to specify a silicon content of less than 0.05 wt. % based on the weight of the magnetite toner. The Examiner has carefully reviewed the specification and is unable to find any disclosure of the value "less than 0.05 wt. %" in defining the amount of silicon in the low-silicon magnetites. Certain ranges are disclosed for the content of silicon in the magnetite on specification page 4, lines 2-4, and specific silicon contents for certain exemplified magnetites at specification page 12, line 3. However, there is no disclosure in these passages of the currently claimed range of "less than 0.05 wt. %". The newly claimed range constitutes new matter.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ Claim 1 as amended is indefinite because there is no antecedent basis for "the magnetite toner" earlier in the claim. It appears that this should state "based on the weight of the magnetites" and such a correction is suggested. Claims 2-4 should also be amended to clarify that the weight is based on the weight of the magnetite.

✓ Claim 5 remains indefinite because the specification as filed does not set forth the manner in which sphericity is determined. In response to this rejection a declaration by applicant was provided explaining how sphericity was determined in the instant invention. However, the application must be complete as filed. It was not. There is no guidance in the specification as to how to determine sphericity. It appears that other methods of determining sphericity are known in the relevant art and that each method would give different results. For example US Patent 6,416,917 uses a different device and formula from that disclosed in the declaration to give a numerical representation of sphericity (col. 2, l. 66 - col. 3, l. 12). It

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appears from the evidence of record that there are a number of different methods to determine sphericity that would produce values within the scope of those claimed and that the same particles would produce different values depending on the method used. The specification does not provide guidance of the method used to determine sphericity in the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

✓ Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 197 02 431 considered with the description of the document on specification page 3.

This rejection was set forth in the last Office action based on the limitation of a "low-silicon magnetite." The claims have been amended to require the content of silicon in the magnetite or be less than 0.05 wt. %. The German document discloses formation of toner using low-silicon magnetites (see document col. 4, l. 63-64 & claim 9) where the content of silicon is 0.05 to 2.0 wt. % (Abstract). Based on the disclosure of 0.05 wt. % silicon in the magnetite, the artisan of ordinary skill would have found it obvious to use slightly less than the disclosed amount of 0.05 wt. % silicone because the artisan would expect equivalent usefulness for silicon content as close as possible to 0.05 wt. %. Such values are included within the scope of the claims. The magnetite has the same characteristics as specified in instant claim 5 noting document col. 2, l. 33-53 and thus suggests these features for the magnetite.

Double Patenting

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 15 of copending Application No. 09/944880. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are presented in product-by-process form concerning the method of making the magnetite and this magnetite appears to fall within the scope of the instant claims. The process disclosed in the copending claims appears to be included within the scope of the process disclosed in the instant specification (pp. 4-5) for formation of the magnetite. Thus, the copending application is seen as producing a low-silicon magnetite in the process claims and claiming the product of the process in a toner in claims 14 and 15. The product of the copending claim is seen as falling within the scope of the instant claims. Applicants amendments do not overcome this rejection because the content of silicon in the copending application claims remains within the scope of the instant claims. No specific ground of traversal was presented in the recent response.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.


CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
January 7, 2003